

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD APPLEBAUM
and
PETER J. WILK

Appeal No. 2003-1341
Application No. 09/447,071

ON BRIEF

Before OWENS, WALTZ and MOORE, Administrative Patent Judges.
MOORE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claim 34. Claims 1-33 are allowed. Thus, only claim 34 is before us on this appeal. It reads as follows:

34. A method for playing a table tennis game, comprising:

providing a table tennis table having a width exceeding a standard table tennis table width;

providing a first paddle, a second paddle, a third paddle, a fourth paddle, and a table tennis ball;

striking said ball with said first paddle held by a first player located at one end of said table, said second paddle being held by a second player also located at said one end of said

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table, the striking of said ball by said first paddle propelling said ball from said one end of said table towards another end of said table, said third paddle and said fourth paddle being held respectively by a third player and a fourth player both located at said another end of said table;

as said ball arrives at said another end of said table, striking said ball with said third paddle, the striking of said ball by said third paddle propelling said ball from said another end of said table towards said one end of said table; and

as said ball arrives at said one end of said table, striking said ball with one of said first paddle and said second paddle, the striking of said ball by said one of said first paddle and said second paddle propelling said ball from said one end of said table back towards said another end of said table, said one of said first paddle and said second paddle being determined in accordance with a direction of motion of said ball after being struck by said third paddle and positions of said first player and said second player relative to said ball upon arrival of said ball at said one end of said table, so that as said ball arrives at said one end of said table, said ball may be struck by said first paddle rather than said second paddle.

The References

In rejecting the claim under 35 U.S.C. § 103(a), the examiner relies upon the following references:

Paddle Tennis: Official Rules of Play, U.S. Paddle Tennis Association, Copyright 1996. ("Rules of Paddle Tennis Play")

The Doubles Game: The Rules of Tennis, United States Tennis Association, Copyright 2001. ("Rules of Tennis Play")

The Rejections

Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Rules of Paddle Tennis Play and the Rules of Tennis Play.

The Invention

The invention relates to a doubles game of table tennis having a mode of play said to be different from conventional table tennis. In play, either player on either end may return a volley. (Appeal Brief, page 2, lines 12-22). A table wider than a standard table is used. (Id., page 3, lines 5-7). Further details of the claimed subject matter are recited in claim 34, reproduced above.

The Rejection of Claim 34 Under 35 U.S.C. § 103(a)

The examiner has found that table tennis has been in existence since about 1880 and various sizes of tables have been in use. (Examiner's Answer, page 3, lines 8-10). The examiner has also found that the manner of play described in the claim is as the rules describe (Id., page 3, lines 12-15). The examiner then concludes that it would have been obvious to provide balls and paddles and use a table to play table tennis and it would have been obvious to vary the rules to play the game (Examiner's Answer, page 3, lines 17-21).

The appellants, on the other hand, urge that the rules state that each player on a team can strike only every other ball, whereas the claimed method allows for each player to make each return. The appellants urge that the principal reference

actually teaches away from the claimed method in requiring table tennis players to not play by the appellants' method. (Appeal Brief, page 4, line 14 - page 5, line 3).

The appellants also urge that one of ordinary skill in the art would not look to the Rules of Tennis Play for use in table tennis as they are separate sports.

Finally, it is urged, nothing in the references teaches the use of a wider width table. (Id., page 5, lines 4-17).

First, we note that we agree with the examiner that the Rules of Table Tennis play permit players to play as instantly claimed, i.e. to not alternate in making returns (See Rule 34, Note). Additionally, Rule 32 contemplates receiving out of order. Consequently, we agree that the claimed order of play would have been obvious to one of ordinary skill in the art.

Second, we disagree that one of ordinary skill in the art would not look to the Rules of Tennis Play for guidance. The Rules of Table Tennis Play themselves refer to the Rules of Tennis Play as governing (see page 3 of Rules of Play, line last). The rules of tennis likewise allow for partners to return the balls in non-alternating ways (see Rule 40, USTA Comment, lines 1-2).

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Finally, we observe that the examiner first made a factual finding that table tennis can be, and historically has been, played upon a wide variety of table sizes. The appellants have not rebutted this factual finding; instead, they have only stated that the references fail to show this feature. Further, where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Clearly, the setting of a table tennis table dimension¹ is an arbitrary rule making exercise and not critical. Selecting a table wider than the standard width would have been obvious to one of ordinary skill in the art at the time the invention was made.²

We therefore affirm this rejection.

1 We question whether this limitation complies with 35 U.S.C. § 112, second paragraph. Various dimensions may be permitted for table tennis, paddle tennis, or Ping-Pong®, depending on the league rules and whether free or tournament play is underway. In the event further prosecution is undertaken regarding this application, the appellants and the examiner should visit this issue.

2 In the event of further prosecution, we direct the examiner to consider US Patent 4,521,017, which discloses a table for table tennis of 6 feet in width (abstract, line 11), and US Patent 3,717,343, which suggests tables which are wider, longer and lower than table tennis tables (column 2, lines 49-50), up to 12 feet wide (column 4, lines 25-26). The USA Table Tennis rules, rule 1.1, appear to specify a table of 5 feet in width. Copies of these references are attached hereto.

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Summary of Decision

The rejection of claim 34 under 35 U.S.C. § 103(a) over Rules of Table Tennis Play and the Rules of Tennis Play is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JAMES T. MOORE)	
Administrative Patent Judge)	

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COLEMAN SUDOL SAPONE, P.C.
714 COLORADO AVENUE
BRIDGEPORT CT 06605-1601